

## REMARKS

### A. 35 U.S.C. §103

Claims 25-29, 33, 37-41, 45 and 48-54 were rejected under 35 U.S.C. § 103 as being obvious in view of the ENC-150 Encoder Mounting Instructions (hereinafter “AcuRite Manual”) and Pasek. Applicant traverses this rejection. Claims 33 and 45 each recite a method that includes attaching a template to a reading head bracket, which is attached to a machine tool, subsequent to positioning the template. It is noted that the Office Action has conceded that the AcuRite Manual does not disclose such attaching. In order to overcome the deficiencies of the AcuRite Manual, the Office Action has asserted that Pasek discloses a method of mounting that involves a template and that it would have been obvious to attach Pasek’s template to the reading head bracket disclosed in the AcuRite Manual.

Applicant traverses the above-described rejection for several reasons. First, Pasek is directed to nonanalogous art, which is improper under 35 U.S.C. § 103.

The test for nonanalogous art is as follows:

The determination that a reference is from nonanalogous art is therefore two-fold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. In re Deminski, 796 F.2d 436, 230 U.S.P.Q.

313 (Fed. Cir. 1986) citing In re Wood, 559 F.2d 1032, 1036, 202 U.S.P.Q. 171, 174 (C.C.P.A. 1979).

Upon applying the first prong of the test, one sees that Pasek is not within the Applicant's field of endeavor. Applicant's claimed invention is in the field of methods of mounting a position measuring device to a machine tool. In contrast, Pasek does not relate in any way to methods of mounting a positioning measuring device to a machine tool. Instead, Pasek is directed to a template to be used to identify locations for holes to be drilled for mounting a door hardware. (Col. 1, l. 49 – Col. 2, l. 30). Since there is no mention in Pasek of mounting a position measuring device to a machine tool, Pasek is not within Applicant's field of endeavor.

Besides not being within Applicant's field of endeavor, Pasek is not reasonably pertinent to the particular problem with which the Applicant was involved. As stated on pages 3 and 4 of Applicant's specification, the problem of multiple attachments and removals of linear encoders and their components to mark and form holes are a concern of Applicant's claimed invention. It is clear that Pasek does not address Applicant's problem. In particular, Pasek primarily concerns the problems regarding the use of templates in connection with door hardware. (Col. 1, ll. 50-52). Pasek regards the problem of fixing a template to different parts which have to be mounted in a certain geometric relationship.

Based on the above discussion, Pasek fails the second prong of the test.

Accordingly, it is respectfully submitted that a person having ordinary skill in the art of designing improved methods for mounting a position measuring device to a machine tool would not, without other suggestion, turn to the completely non-analogous device of Pasek used for door hardware. For this reason alone it is felt that the argued combination is inappropriate and that claims 25-29, 33, 37-41, 45 and 48-54 should be allowed.

Even should Pasek be deemed analogous art, it is respectfully submitted that the combination of the AcuRite Manual and Pasek under § 103 is improper, because of a lack of motivation to do so. Independent claims 33 and 45 each recite a mounting process that includes a template with mounting holes, wherein the process includes marking all necessary mounting holes through the mounting holes. In contrast, Pasek discloses designations 24, 62 that are mere markings and not holes. Holes are formed in a member by drilling through the designations. Since there is no motivation in Pasek to replace its designations with holes, the rejection is improper and should be withdrawn.

The rejection is improper for the additional reason that claims 33 and 45 each recite a mounting process wherein the template is detached from the reading head bracket prior to forming the holes in the machine tool. In contrast, Pasek's template is either 1) removed from the member after the holes are formed via drilling (Col. 8, ll. 20-23) or 2) not removed from the member at all prior to or after the forming of the holes (Col. 8,

ll. 23-27). Since the designations of Pasek need to be present for forming the holes in the member, it follows that the template with the designations cannot be removed prior to forming the holes since such removal would make it impossible to form the holes. Since Pasek teaches away from removing Pasek's template prior to forming the holes, the rejection is improper and should be withdrawn.

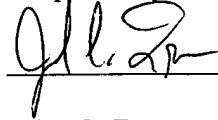
It should be noted that even if there was prior art indicating that a template for mounting a position measuring device to a machine tool was known. There still has been no showing that one of ordinary skill in the art would be motivated to attach such a template to the reading head bracket described in the AcuRite Manual. Without such motivation, the claims should be allowed.

### **CONCLUSION**

In view of the arguments above, Applicant respectfully submits that all of the pending claims 25-29, 33, 37-41, 45 and 48-54 are in condition for allowance and seeks an early allowance thereof. If for any reason, the Examiner is unable to allow the application in the next Office Action and believes that an interview would be helpful to

resolve any remaining issues, she is respectfully requested to contact the undersigned attorneys at (312) 321-4200.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J.C. Freeman", is written over a horizontal line.

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